Attorney Docket No. 9540-6   PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Bredow et al.   Confirmation No.: 8307
Serial No.: 09/896,802   Group Art Unit: 2676
Filed: June 29, 2001   Examiner: Po Wei Chen
For: METHOD AND COMPUTER PROGRAM PRODUCT FOR USING A SCROLLING
        COMPUTER MOUSE TO SELECT PAGES OF A SET OF LINKED WEB PAGES

                                    Date: August 1, 2005

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P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)

1.   Transmitted herewith is the APPEAL BRIEF for the above-identified application, pursuant to the Notice of Appeal filed on May 31, 2005.

2.   This application is filed on behalf of
      ☐   a small entity.

3.   Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:
      ☐   small entity $250.00
      ☒   other than small entity $500.00

                              Appeal Brief fee due $_500.00_____

☒   Any additional fee or refund may be charged to Deposit Account
     50-0220.

                              Respectfully submitted,

                              D. Randal Ayers
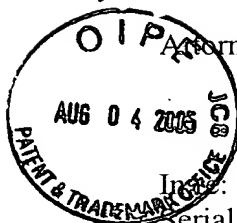   Registration No.   40,493

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APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

Sir:

This Appeal Brief is filed pursuant to the *Notice of Appeal to the Board of Patent Appeals and Interferences* filed May 31, 2005.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due may be charged to Deposit Account No. 50-0220.

Real Party In Interest

The real party in interest is assignee Lenovo (Singapore) Pte Ltd. of Singapore.

Related Appeals and Interferences

Appellants are aware of no appeals or interferences that would be affected by the present appeal.

Status of Claims

Claims 1-29 remain pending. Each pending claim stands finally rejected. Appellants appeal the final rejection of Claims 1-29. The attached Appendix A presents the pending claims as finally rejected in the Official Action of March 1, 2005.

Status of Amendments

The attached Appendix A presents the claims as they currently stand. Appellants filed a Request for Reconsideration on August 20, 2003, an Amendment on April 14, 2004, a

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Response on October 18, 2004, and a Request for Reconsideration on April 25, 2005. Each of these papers were entered. Only the Amendment of April 14, 2004 made changes to the claims, adding new Claims 27-29.

Summary of Claimed Subject Matter

A.   Claim 1

Independent Claim 1 is directed to a method for browsing a set of linked web pages. As shown, for example, in portions of Fig. 3, a scrolling output is detected. (*See* Fig. 3, decision box between boxes 310 and 315). The scrolling output may, for example, comprise a scrolling signal from a scroll wheel. In response to the scrolling output, the URL of a web page is determined. (*See* Fig. 3, box 320). The web page for which the URL was determined may then be accessed by a web browser. (*See* Fig. 3, box 325).

B.   Claim 3

Independent Claim 3 is directed to a method for using a scroll mouse to browse a set of linked web pages. This method is also displayed, for example, in Fig. 3 of the present application. Pursuant to the method of Claim 3, a source web page that is a member of a set of linked web pages is displayed . (*See* Fig. 3, box 305). Then the scrolling output of a scroll mouse is detected, and the sense of direction (e.g., forward or backward) of the scrolling output is determined. (*See* Fig. 3, boxes 310 and 315). Based on the identified sense of direction, the URL associated with a destination page that is a member of the set of linked web pages is determined. (*See* Fig. 3, box 320). Then, the destination web page having the identified URL is accessed by a web browser. (*See* Fig. 3, box 325).

C.   Claims 14 and 16

Independent Claim 14 is directed to a programmable media that contains programmable software that may be used to implement the method of independent Claim 1. Independent Claim 16 is directed to a programmable media that contains programmable software that may be used to implement the method of independent Claim 3.

None of the independent claims include means-plus-function recitations.

Grounds of Rejection to be Reviewed on Appeal

1.   The rejections of Claims 1, 14, 27 and 29 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,211,878 to Cheng ("Cheng").

2.   The rejections of Claims 2-4, 8-13, 15-17, 21-26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Armstrong. Note that the rejection of Claims 3-4, 8-13, 16-17, 21-26 and 28 in the Final Office Action includes a typographical error in that the first sentence of the rejection states that the rejections are based on U.S. Patent No. 6,567,079 to Smailagic et al. ("Smailagic") as opposed to Cheng. (*See* Final Office Action at 4, ¶ 11). However, the remainder of the rejection makes clear that the rejections are based on the combination of Cheng and Armstrong as opposed to the combination of Smailagic and Armstrong.

3.   The rejections of Claims 5 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Armstrong and Smailagic.

4.   The rejections of Claims 6 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Armstrong and U.S. Patent No. 5,530,455 to Barros ("Barros").

5.   The rejections of Claims 7 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Armstrong and U.S. Patent No. 5,877,766 to Bates et al. ("Bates").

Argument

I.   Introduction

Claims 1, 14, 27 and 29 stand rejected as being anticipated by Cheng under 35 U.S.C. § 102(e). For a claim to be anticipated by Cheng under Section 102, Cheng must disclose, either expressly or inherently, each and every element recited in the claim. The remaining claims on appeal (Claims 2-13, 15-26 and 28) stand rejected as obvious under 35 U.S.C. § 103. A determination under Section 103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just

before it was made. *Id.* at 1596. The United States Patent and Trademark Office has the initial burden under Section 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art references cited in the rejection, when combined, must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings in the manner suggested. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Thus, in support of a Section 103 rejection, particular evidence from the prior art must be provided showing why a skilled artisan, with no knowledge of the claimed invention, would have combined the cited references in the manner claimed in the rejection. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as recently stated by the Federal Circuit with regard to the selection and combination of references:

> This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Appellants respectfully submit that the pending claims are patentable over the cited references because the cited combination fails to disclose or suggest all of the recitations of

the pending claims, and because the reasoning behind such combination has not been established. The patentability of the pending claims is discussed in detail hereinafter.

II.   Claims 1, 14, 27 and 29 are Not Anticipated by Cheng

A.   The Rejections of Claims 1, 14 and 27 Should be Reversed

Independent Claims 1 and 14 and dependent Claim 27 stand rejected under 35 U.S.C. § 102 as anticipated by Cheng. (Final Office Action, at 2, ¶¶ 1-5). In particular, the Final Office Action cites to Col. 5, line 65 through Col. 6, line 53, Col. 14, lines 36-39 and Figs. 1-3 of Cheng as disclosing each of the recitations of these claims. (Final Office Action, at 2-3, ¶¶ 3-5). Claim 1 of the present application recites:

> 1.   A method of browsing a set of linked web pages, comprising the steps of:
> detecting scrolling output;
> responsive to the scrolling output, determining a URL of a web page; and
> accessing the web page by a web browser.

Claim 14 is a programmable media claim directed to programmable media that contains programmable software that may be used to perform the method of Claim 1.

Cheng describes a remote control unit that can be used to interact with information on a video device such as, for example, a TV that displays web pages. (Cheng at Col. 5, lines 22-25 and Fig. 3). The Final Office Action states that Col. 6, lines 24-29 and 44-48 and Fig. 1 of Cheng discloses the "responsive to the scrolling output, determining a URL of a web page" recitation (the "scrolling output" recitation) of independent Claims 1 and 14 in two different ways. (*See* Final Office Action, at 8-9, ¶ 25). In particular, the Final Office Action states that Fig. 1 of Cheng teaches determining the URL of a web page in response to a scrolling output by:

> (1)   the "Back/Forward" arrows that connect Scroll Mode (box 42) to Display Previous Page Mode (box 45); and
>
> (2)   the unlabelled arrows that connect Frame Turning Mode (box 46) to Display Previous Page Mode (box 45).

As shown in the following sections, neither of the identified aspects of Fig. 1 of Cheng (and the accompanying text) disclose or suggest determining the URL of a web page in response to a scrolling output as recited in Claims 1 and 14.

1.   The Connection Between Boxes 42 and 45 of Fig. 1 Does Not
       Teach the "Scrolling Output" Recitation

As noted above, the Final Office Action first takes the position that the arrows labeled "Back/Forward" that connect Scroll Mode (box 42) to Display Previous Page Mode (box 45) in Fig. 1 of Cheng teach " in response to a scrolling output, determining the URL of a web page." (Final Office Action at 8, ¶ 25). As made clear in Cheng, the "Back/Forward" designation refers to "Back" button 84 and "Forward" button 86 on the remote control device of Cheng. (*See, e.g.,* Cheng at Fig. 2 and Col. 6, lines 24-26). These physical "Back" and "Forward" buttons, like the virtual "Previous" and "Next" buttons referred to in the Background section of the present application, are buttons that "the viewer must repeatedly click" to move through the information that is to be viewed. (*See* Application at 1). The "Back" and "Forward" buttons of Cheng, like the "Previous" and Next" buttons described in the present application, do not provide a "scrolling output" as recited in Claims 1 and 14. Accordingly, the arrows labeled "Back/Forward" that connect Scroll Mode (box 42) to Display Previous Page Mode (box 45) do not teach or disclose "responsive to the scrolling output, determining the URL of a web page" as recited in Claims 1 and 14.

Appellants recognize that in Fig. 1 of Cheng, the Forward and Back buttons can be activated while the remote control device is in Scroll Mode (box 42). In the Final Office Action, the Examiner appears to rely on this aspect of Fig. 1 to argue that Cheng discloses determining the URL of a web page in response to a scrolling output. However, Cheng very clearly indicates that Scroll Mode (box 42) is a mode in which the user of the remote control can use a scroll wheel to scroll through a single web page. (*See, e.g.,* Cheng at Col. 6, lines 8-13, stating "in scroll Mode 42, the web browser may advance or regress through information **on a web page** according to a relative rotation of a user interface device such as a wheel") (emphasis added). While Scroll Mode (box 42) may be entered in response to a scrolling signal (*see* Fig. 1 of Cheng), Scroll Mode (box 42) is only used to scroll through a single web page and is not used to determine the URL of another web page. Once in Scroll Mode (box 42), the user has the options of (1) moving to Scrolling Page Mode (box 44) or (2) moving to Display Previous Page Mode (box 45). However, neither the Scrolling Page Mode (box 44) or the Display Previous Page Mode (box 45) are entered in response to a scrolling output – instead these modes are entered in response to either conventional page up/down

buttons or conventional forward/back buttons. Thus, as conventional non-scrolling buttons are used to enter Display Previous Page Mode (box 45) from Scroll Mode (box 42) as opposed to a scrolling output, Appellants respectfully submit that the connection between boxes 42 and 45 of Fig. 1 of Cheng does not disclose determining the URL of a web page in response to a scrolling output as recited in Claims 1, 14 and 27.

> **2.   The Connection Between Boxes 46 and 45 of Fig. 1 Does Not Teach the "Scrolling Output" Recitation**

As noted above, the Final Office Action also states that the "scrolling output" recitations of Claims 1, 14 and 27 is taught by the arrows in Fig. 1 of Cheng that connect the Frame Turning Mode (box 46) to the Display Previous Page Mode (box 45). (Final Office Action at 8, ¶ 25). Appellants respectfully submit that this also is not the case for at least two independent reasons.

> **a.   Cheng Does Not Disclose Determining the URL of a Web Page**

As noted above, the Final Office Action relies on the statement at Col. 6, lines 24-28 of Cheng as teaching determining the URL of a web page in response to a scrolling output as recited in Claims 1, 14 and 27. (*See* Final Office Action at 8, ¶ 25). The cited portion of Cheng states:

> Box 46 denotes a display previous page mode which can be activated by signals from a back or forward button or a combination of the web browser previously being in a frame turning mode as denoted by box 46 and generation of a scroll signal from either a scroll button or scroll wheel.

As shown below, the above-quoted excerpt from Cheng refers to actions that are taken to **navigate through a single web page**. Thus, Cheng does not disclose "responsive to the scrolling output, determining the URL of a web page" but instead merely describes functions that may be used to navigate an already-accessed web page.

As an initial matter, Appellants note that nowhere does Cheng state that a URL of a web page is determined in response to a scrolling signal. Instead, what the cited portion of Cheng states is that the "display previous page mode" may be entered through the "frame turning mode" **46**. Cheng explains that:

> Box 46 denotes a frame mode which is activated upon a signal received from a user interface device such as a frame button. Once in the frame turning mode 46, a user can move through frames **of the web page** or to scroll by displaying previous pages of **the web page document**.

(Cheng at Col. 6, lines 44-50, emphasis added). This is the **only** discussion in Cheng of the Display Previous Page Mode (box 45). By using the **singular** form of the phrase "web page", Cheng makes clear that the Display Previous Page Mode (box 45) is used to navigate **a single web page** as opposed to being used to browse a linked set of web pages. Cheng again makes clear that the scrolling is within a single web page in its general description of the Scroll Mode of Fig. 1:

> While in scroll mode 42, the web browser may advance or regress through information **on a web page** according to a relative rotation of s user interface device such as a wheel . . . .

(Cheng at Col. 6, lines 9-12, emphasis added).[1] Thus, the cited portion of Cheng does not disclose determining the URL of a web page in response to a scrolling signal, as the Display Previous Page Mode (box 45) is only used to navigate the already accessed web page.

In fact, Appellants respectfully submit that when Cheng is read in its entirety, it is clear that the Display Previous Page Mode (box 45) is used for **backward or forward movement through highlighted or selected text**. Specifically, in describing the actions that can be taken from the Scroll Mode (box 42) of Fig. 1, Cheng states:

> [W]hile in scroll mode, a user interface device such [as] a button prescribed for a specific web based function like an "enter" command may be employed. Other examples include user interface devices or buttons that are designed for page up and page down functions, **backward and forward movement of highlighted or selected text**, or frame advance for a web browser.

(Cheng at Col. 6, lines 13-19, emphasis added). Correlating the above-quoted statement with Fig. 1 (which is what the statement is describing), it is clear that the "page up and page down functions" refer to the Scrolling Page Mode (box 44) which is entered by pressing the page up or page down buttons while in Scroll Mode (box 42). It is equally clear that the reference to "backward and forward movement of highlighted or selected text" in the above quote

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[1] Likewise, Fig. 8 of Cheng and the discussion thereof shows that the frame turning mode **46** is used to navigate a single web page that is divided into a series of frames. (Cheng at Col. 8, lines 42-49 and Fig. 8).

refers to the arrows connecting Scroll mode (box42) and Display Previous Page Mode (box 45) of Fig. 1, as these are the only arrows associated with the Scroll Mode (box 42) that use the backward and forward buttons.[2] Thus, it is clear that the Display Previous Page Mode (box 45) has nothing to do with determining the URL of another web page, but instead involves moving through highlighted or selected text on the web page that is currently being viewed.

The remainder of Cheng confirms that this is the case. For example, the Summary of the Invention section of Cheng states that the objects of the invention are fulfilled by a remote control unit that includes seven separate user interfaces. (*See* Cheng at Col. 3, lines 20-54). Independent Claim 1 likewise identifies these seven user interfaces. These seven user interfaces can easily be associated with seven of the buttons provided on the remote control unit of Fig. 2. In particular, the first user interface – which "generat[es] a signal upon actuation that activates information displayed on the video device" – comprises the Enter button 68. The second user interface – which "generat[es] a signal upon actuation that selects information displayed on the video device" – comprises the combination of the Scroll Wheel 66 and the Frame button78. (*See* Cheng at Col. 8, lines 43-46 and Claim 6). The third user interface – which "scrolls through information" – comprises the Scroll Wheel 66. The fourth user interface – which "advances information in a page format" – comprises the Page Up button 80. The fifth user interface – which "regresses information in a page format" – comprises the Page Down button 82. The sixth user interface – which "advances information incrementally" – comprises the Forward button 86. The seventh user interface – which "regresses information incrementally" – comprises the Back button 84. This further confirms that the Display previous Page Mode (box 45) involves moving backward or forward through highlighted or selected text as described at Col. 6, lines 13-19 of Cheng and does not involve determining the URL of a web page in response to a scrolling output as recited in Claims 1, 14 and 27.

For each of the above reasons, Appellants respectfully submit that Cheng does not teach or disclose "responsive to the scrolling output, determining the URL of a web page" as recited in Claims 1, 14 and 27. In the Final Office Action, the Examiner appears to assume

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[2] The reference to the frame advance mode in the above quote refers to the Frame Turning Mode (box 46), which is entered from Scroll Mode (box 42) by moving first to Display

that the Display Previous Page Mode (box 45) of Fig. 1 corresponds to the function associated with a "Back" button on a standard web browser (i.e., pulling up a previously viewed web page). However, nothing in Cheng indicates that this is the case and, as discussed above, the description in Cheng actually makes clear that the Display Previous Page Mode is used to move through the already displayed web page. Thus, for each of the above reasons, the rejections of Claims 1, 14 and 27 should be reversed.

> b.   The Display Previous Page Mode (Box 45) of Cheng is
> Not Entered in Response to a Scrolling Output

The rejections of Claims 1, 14 and 27 should also be withdrawn because these rejections are based on the assumption that the Display Previous Page Mode (box 45) of Fig. 1 is entered in response to a scrolling signal. (*See* Final Office Action at 2, ¶ 3 and 8, ¶ 25). This assumption is based on the statement at Col. 6, lines 24-28 of Cheng that "Box 46 denotes a display previous page mode which can be activated by . . . a combination of the web browser previously being in a frame turning mode as denoted by box 46 and generation of a scroll signal from either a scroll button or scroll wheel." This statement in the specification of Cheng, however, is directly **contradicted by Fig. 1 of Cheng, which shows that when a scrolling signal is received while in Frame Turning Mode (box 46), the scrolling signal causes the remote control to enter the Turn to Frame Mode (box 54) as opposed to the Display Previous Page Mode (box 45)**. (*See* Cheng at Fig. 1, showing that when a "scroll" input is received at box 46 operations move to box 54). The specification of Cheng confirms that this is the case. (*See* Cheng at Col. 6, lines 51-54). Of course, if receipt of a scrolling signal causes operations to move from box 46 to box 54, it is axiomatic that receipt of such a scrolling signal does not cause operations to move from box 46 to box 45. Thus, Appellants also submit that when read in its entirety, it is clear that Cheng does not teach that the Display Previous Page Mode (box 45) is entered in response to a scrolling output. This provides an independent basis for withdrawal of the rejections of Claims 1, 14 and 27.

Previous Page Mode (box 45) and then to Frame Turning Mode (box 46).

B.   Claim 29 is Independently Patentable Over Cheng

Claim 29 depends from Claim 1 and this is patentable for each of the reasons discussed above that Claim 1 is patentable. Claim 29 further recites that "the URL of the web page is determined in response only to the scrolling output." The Final Office Action cites to Col. 5, line 65 through Col. 6, line 53 and Figs. 1-3 of Cheng as teaching the recitation of Claim 29. (Final Office Action at 3, ¶ 6). Nothing in the cited portion of Cheng, however, teaches or discloses the recitation of Claim 29.

While the Final Office Action cites to over a full column of Cheng in rejecting Claim 29, the Response to Arguments section of the Final Office Action (pages 8-9) makes clear that the rejection is based on the sentence set forth at lines 24-29 of Col. 6, which states:

> Box 46 denotes a display previous page mode which can be activated by signals from a back or forward button or a combination of the web browser previously being in a frame turning mode as denoted by box 46 and generation of a scroll signal from either a scroll button or scroll wheel.

This sentence purports to state two different ways for entering the Display Previous Page Mode. In the first of these ways, the Display Previous Page Mode is entered using the forward or back button as stated in the first part of the above-quoted sentence. For this to occur, it is necessary for the device to first receive a scroll signal and enter the Scrolling Mode 42. (*See* Cheng at Fig. 1). Accordingly, the first way of entering the Display Previous Page Mode of Cheng does not describe determining the URL of the web page "in response **only** to [a] scrolling output", but instead is entered in response to a forward or back button that is received some time after a scrolling signal is received. Likewise, the second purported way of entering the Display Previous Page Mode, which is set forth in the last part of the above-quoted sentence, expressly states that the Display Previous Page Mode is entered in response to two things, namely the (1) web browser previously being in a frame turning mode as denoted by box 46 and (2) generation of a scroll signal. Accordingly, it is clear that Cheng also fails to teach or disclose the recitation added by dependent Claim 29.

III.   Claims 2 and 15 are Patentable Over the Cited Art

Claims 2 and 15, which depend, respectively from Claims 1 and 14, stand rejected under 35 U.S.C. § 103 as obvious over the combination of Cheng and Armstrong. Appellants

respectfully submit that these claims are patentable for at least the same reasons, discussed above, that Claims 1 and 14 are patentable, as neither Cheng nor Armstrong teach or disclose "responsive to the scrolling output, determining a URL of a web page."

IV. Claims 3-4, 8-13, 16-17, 21-26 and 28 are Patentable Over the Cited Art

Claims 3-4, 8-13, 16-17, 21-26 and 28 stand rejected under 35 U.S.C. § 103 as obvious over the combination of Smailagic and Armstrong. As noted above, Appellants believe that this rejection reflects a typographical error and that the Examiner intended to reject these Claims based on the combination of Cheng and Armstrong, as each paragraph of the rejection following the first paragraph refers to the alleged contents of Cheng as opposed to the teachings of Smailagic. Accordingly, Appellants have responded to this rejection as if it were based on the combination of Cheng and Armstrong.

A. Claims 3-4, 9, 12-13, 16-17, 22, 25-26 and 28 are Patentable Over the Cited Art

Claim 3 is an independent method Claim, and Claims 4, 9, 12-13 and 28 depend from Claim 3. Claim 16 is a programmable media claim that corresponds to Claim 3, and Claims 17, 22 and 25-26 each depend from Claim 16. Claim 3 recites:

3.   A method for using a scroll mouse to browse a set of linked web pages, comprising the steps of:

displaying a source page that is a member of a set of linked web pages;

detecting scrolling output of a scroll mouse while the source page is displayed;

determining a sense of direction of the scrolling output;

responsive to the sense of direction, determining a URL associated with a destination page that is a member of the set of linked web pages; and

accessing the destination web page by a web browser.

Appellants respectfully submit that the cited art does not render Claims 3-4, 9, 12-13, 16-17, 22, 25-26 and 28 obvious for at least the following reasons.

1.   The Cited Art Does Not Disclose a Set of Linked Web Pages

As an initial matter, the rejections of Claims 3-4, 9, 12-13, 16-17, 22, 25-26 and 28 should be reversed because the cited art does not teach or disclose displaying a source page

that is a member of a set of linked web pages" as recited in both independent Claims 3 and 16. The Final Office Action generally states that this teaching can be found somewhere in the passage of Cheng starting at Col. 5, line 65 through Col. 6, line 53 and/or in Figs. 1-3 of Cheng, but no additional explanation is provided. Appellants have very carefully read the cited passage of Cheng and have found that nowhere therein is reference made to a set of linked web pages. Accordingly, the failure of Cheng (or the secondary reference, Armstrong) to teach or disclose this recitation of Claims 3 and 16 provides grounds for reversing the rejections of Claims 3-4, 9, 12-13, 16-17, 22, 25-26 and 28.

While the Final Office Action fails to provide specificity with respect to where the "set of linked web pages" recitation of Claims 3 and 16 is found in Cheng, Appellants assume that the Examiner contends that this recitation is found in the Display Previous Page Mode (box 45) of Fig. 1. However, as discussed above, nowhere does Cheng teach or disclose that the Display Previous Page Mode retrieves a different web page having a different URL, let alone that it is retrieving a web page that is one of a linked set of web pages as recited in Claims 3 and 16. Instead, the Final Office Action appears to assume that the "previous page" that is displayed is a different web page having a different URL, despite the fact that Cheng never states that this is the case and in fact expressly states that the Display Previous Page Mode involves the same web page. (*See, e.g.,* Cheng at Col. 6, lines 44-48). Accordingly, the rejections of Claims 3 and 16, and the claims depending therefrom, should be reversed.

2. The Cited Art Does Not Teach Determining a Web Page URL in Response to the Sense of Direction of a Scrolling Output

Independent Claims 3 and 16 also each recite "determining a sense of direction of the scrolling output" and then "responsive to the sense of direction, determining a URL associated with a destination page that is a member of the set of linked web pages." As discussed in detail above with respect to Claims 1 and 14, Cheng does not teach or disclose determining a URL of a different web page in response to anything, let alone doing so in response to a "scrolling output" as recited in independent Claims 1 and 14 or in response to the sense of direction of a scrolling output as recited in independent Claims 3 and 16. As Appellants grounds for contending that Cheng fails to teach "determining a URL associated with a destination web page" in response to a "scrolling output" (or to the sense of direction of a scrolling output) is set forth in detail in Section II above,

Appellants will not repeat those grounds here, but instead incorporates those arguments by reference.

B.   Claims 8, 10-11, 21 and 23-24 are Patentable Over the Cited Art

Claims 8 and 10-11 depend from Claim 3. Claims 21 and 23-24 depend from Claim 16. Accordingly, Claims 8, 10-11, 21 and 23-24 are patentable for each of the reasons discussed in the preceding section that independent Claims 3 and 16 are patentable over the cited art. Appellants also respectfully submit that Claims 8, 10-11, 21 and 23-24 are independently patentable over the cited art as well.

In particular, each of Claims 8, 10-11, 21 and 23-24 involve determining the URL of a web page where the URL is associated with either the "next" button of a source page and/or a "previous" button of the source page. As explained, for example, at page 5, line 9 through page 6, line 17 of the present specification, in certain embodiments of the present invention, the scrolling output may be used to scroll through a linked set of web pages that correspond to the "**next**" and "**previous**" buttons that are displayed on the web browser. Such "next" and "previous" buttons may be used, for example, to scroll through the pages of an on-line catalog or to view a series of search results. As explained at page 6, line 18 through page 7, line 6 of the present specification, according to further embodiments of the present invention, the scrolling output may be used to scroll through the web pages that correspond to the "**forward**" and "**back**" buttons that are displayed on the web browser. Claims 8, 10-11, 21 and 23-24 are directed to the first, not the second, of these different embodiments.

Appellants respectfully submit that Cheng clearly does not disclose determining the URL of a web page that is associated with either the "next" button or the "previous" button of a source page. This can readily be observed from Figs. 1 and 2 of Cheng, which make no mention of "next" or "previous" buttons, while showing "forward" and "back" buttons. The lack of any such teaching in Cheng is implicitly admitted, in paragraph 13 of the Final Office Action. In paragraph 13, the Examiner rejects Claims 8, 10-11, 21 and 23-24 without pointing to any additional portion of Cheng as teaching determining the URL of a web page that is associated with either the next button of a source page or the previous button of the source page. Instead, the Final Office Action just conclusively states that since both next/previous and forward/back buttons may be

programmed in HTML and/or Java, the invention of Claims 8, 10-11, 21 and 23-24 would have been obvious. (*See* Final Office Action at 5-6, ¶ 13). Appellants respectfully submit that this is not an adequate showing to support an obviousness rejection, as nothing in Cheng or the other cited references indicates that a scroll wheel or button(s) may be used to scroll through a linked set of web pages that are associated with "next" and "previous" buttons of a web browser. Accordingly, the rejections of Claims 8, 10-11, 21 and 23-24 should be withdrawn for this additional reason.

V.   Claims 5 and 18 are Patentable Over the Cited Art

Claims 5 and 18, which depend, respectively from Claims 1 and 14, stand rejected under 35 U.S.C. § 103 as obvious over the combination of Cheng, Armstrong and Smailagic. Appellants respectfully submit that these claims are patentable for at least the same reasons, discussed above, that Claims 1 and 14 are patentable, as none of the cited references teach or disclose "responsive to the scrolling output, determining a URL of a web page."

VI.   Claims 6 and 19 are Patentable Over the Cited Art

Claims 6 and 19, which depend, respectively from Claims 1 and 14, stand rejected under 35 U.S.C. § 103 as obvious over the combination of Cheng, Armstrong and Barros. Appellants respectfully submit that these claims are patentable for at least the same reasons, discussed above, that Claims 1 and 14 are patentable, as none of the cited references teach or disclose "responsive to the scrolling output, determining a URL of a web page."

VII.   Claims 7 and 20 are Patentable Over the Cited Art

Claims 7 and 20, which depend, respectively from Claims 1 and 14, stand rejected under 35 U.S.C. § 103 as obvious over the combination of Cheng, Armstrong and Bates. Appellants respectfully submit that these claims are patentable for at least the same reasons, discussed above, that Claims 1 and 14 are patentable, as none of the cited references teach or disclose "responsive to the scrolling output, determining a URL of a web page."

VIII.   Conclusion

In light of the above discussion, Appellants submit that each of the pending claims is patentable over the cited references and, therefore, request reversal of the rejections of Claims 1-29.
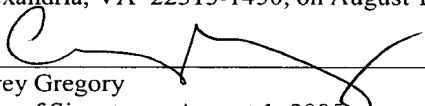
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Carey Gregory
Date of Signature: August 1, 2005.

1.   (Original) A method for browsing a set of linked web pages, comprising the steps of:

detecting scrolling output;

responsive to the scrolling output, determining a URL of a web page; and

accessing the web page by a web browser.

2.   (Original) The method of claim 1, wherein the scrolling output is from a scroll mouse.

3.   (Original) A method for using a scroll mouse to browse a set of linked web pages, comprising the steps of:

displaying a source page that is a member of a set of linked web pages;

detecting scrolling output of a scroll mouse while the source page is displayed;

determining a sense of direction of the scrolling output;

responsive to the sense of direction, determining a URL associated with a destination page that is a member of the set of linked web pages; and

accessing the destination web page by a web browser.

4.   (Original) The method of claim 3, wherein the scroll mouse includes a scroll wheel.

5.   (Original) The method of claim 3, wherein the set of linked pages includes an on-line catalog.

6.   (Original) The method of claim 3, wherein the set of linked pages includes a search list provided by an Internet search engine.

7.   (Original) The method of claim 3, wherein the set of linked pages is identified by a set of URLs held in web browser memory.

8.   (Original) The method of claim 3, wherein the URL is associated with a next button of the source page when the sense of direction is forward and the URL is associated with a previous button of the source page when the sense of direction is backward.

9.   (Original) The method of claim 3, wherein the URL is associated with a forward button of a web browser when the sense of direction is forward and the URL is associated with a back button of the web browser when the sense of direction is backward.

10.   (Original) The method of claim 3, wherein the URL is the URL associated with a next button of the source page.

11.   (Original) The method of claim 3, wherein the URL is the URL associated with a previous button of the source page.

12.   (Original) The method of claim 3, wherein the URL is the URL associated with a forward button of the web browser.

13.   (Original) The method of claim 3, wherein the URL is the URL associated with a back button of the web browser.

14.   (Original) Programmable media containing programmable software for browsing of a set of linked web pages, comprising the steps of:
    detecting scrolling output;
    responsive to the scrolling output, determining a URL of a web page; and
    accessing the web page with a web browser.

15.   (Original) The programmable media containing programmable software of claim 14, wherein the scrolling output is from a scroll mouse.

16.   (Original) Programmable media containing programmable software for browsing of a set of linked web pages using a scroll mouse, comprising the steps of:

        displaying a source page that is a member of a set of linked web pages;

        detecting scrolling output generated by a scroll mouse while the source page is displayed;

        determining a sense of direction of the scrolling output;

        responsive to the sense of direction, determining a URL associated with a destination page that is a member of the set of linked web pages; and

        accessing the destination web page.

17.   (Original) The programmable media containing programmable software of claim 16, wherein the scroll mouse includes a scroll wheel.

18.   (Original) The programmable media containing programmable software of claim 16, wherein the set of linked pages includes an on-line catalog.

19.   (Original) The programmable media containing programmable software of claim 16, wherein the set of linked pages includes a search list provided by an Internet search engine.

20.   (Original) The programmable media containing programmable software of claim 16, wherein the set of linked pages is identified by a set of URLs held in web browser memory.

21.   (Original) The programmable media containing programmable software of claim 16, wherein the URL is associated with a next button of the source page when the sense of direction is forward and the URL is associated with a previous button of the source page when the sense of direction is backward.

22.   (Original) The programmable media containing programmable software of claim 16, wherein the URL is associated with a forward button of a web browser when the sense of direction is forward and the URL is associated with a back button of the web browser when the sense of direction is backward.

23.   (Original) The programmable media containing programmable software of claim 16, wherein the URL is the URL associated with a next button of the source page.

24.   (Original) The programmable media containing programmable software of claim 16, wherein the URL is the URL associated with a previous button of the source page.

25.   (Original) The programmable media containing programmable software of claim 16, wherein the URL is the URL associated with a forward button of the web browser.

26.   (Original) The programmable media containing programmable software of claim 16, wherein the URL is the URL associated with a back button of the web browser.

27.   (Previously Presented) The method of Claim 1, further comprising entering a scrolling mode prior to detecting the scrolling output.

28.   (Previously Presented) The method of Claim 3, further comprising entering a scrolling mode prior to detecting the scrolling output of the scroll mouse.

29.   (Previously Presented) The method of Claim 1, wherein the URL of the web page is determined in response only to the scrolling output.